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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/779,389	02/07/01	MUGALL	G 16547-040820

020350 HM22/0521  
TOWNSEND AND TOWNSEND AND CREW  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO CA 94111-3834

EXAMINER  
KURUMA, B

ART UNIT	PAPER NUMBER
1627	

DATE MAILED: 05/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/779,389	MCGALL ET AL.
	Examiner Barba M. Koroma	Art Unit 1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 February 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims 1-17 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

19) Notice of Informal Patent Application (PTO-152)

20) Other: PTO restriction FAX coversheet

**DETAILED OFFICE ACTION**

1. Please Note: In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at [jyothsna.venkat@uspto.gov](mailto:jyothsna.venkat@uspto.gov) or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

**Restriction/Election**

2. Claims 1-17 are pending in this application.
3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, 13-15 drawn to a method of preparing nucleic acid array on a support classified in class 536, subclass 25.3.
  - II. Claim 12, drawn to a method of preparing and packaging a nucleic acid array, classified in class 536, subclass 23.1.
  - III. Claims 16 and 17, drawn to a nucleic acid array, classified in class 435, subclass 6.

4. The inventions are distinct, each from the other because:

5. Groups I and II are related as different methods of making. They are different because the method of making in group I occurs in non-oxidizing atmosphere, whereas the method of making in group II involves exposure of nucleic acids to unfiltered air. Both processes are patentably distinct because the steps are different, the outcomes are different, and the outcomes are interpreted differently.

6. Groups II and III are related as methods of making and compositions. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make protein libraries. Ultimately, these differences suggest differences in subject matter categorization. Thus, art that anticipates or renders obvious one group does not anticipate or render obvious another.

7. The inventions listed above are deemed patentably distinct and appropriate for restriction as shown, because they are of divergent subject matter, have acquired a separate status in the art, and have separately burdensome manual and/or computer-aided bibliographical searches.

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8. A telephone call was made to Bill Kezer on April 24, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

~~Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).~~

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. All inquiries pertaining to this case should be directed to **Barba M. Koroma**. This examiner can normally be reached at: 703 305 1915, at ***9:00am to 5:00pm, Monday through Friday.***

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, PhD, can be reached at: 703 308 2439. The phone number for the organization where this application or proceeding is assigned is: 703 308 2742. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is: 703 308 1235.

Barba M. Koroma, Ph.D  
Patent Examiner  
AU 1627  
May 7, 2001

*padmashri*  
PADMA SHRI PONNALURI  
Primary Examiner